REMARKS

I.   Introduction

Applicants appreciate the willingness of Examiner Campbell to conduct a telephone interview with the undersigned attorney on September 18, 2008. The following paragraphs contain a summary of the substance of that interview.

II.   35 U.S.C. § 112, First Paragraph, Rejections

Dependent Claims 81 and 82 recite that the first and second buttons operate independently of a scroll functionality, and dependent Claims 83 and 84 recite that first and second portions of web information are not subsets of a larger scrollable portion of web information. These claims were rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey that the inventors had possession of the invention. Applicants respectfully disagree.

Starting first with dependent Claims 83-84, these claims recite that first and second portions of web information are not subsets of a larger scrollable portion of web information. As discussed during the telephone interview, these claims are supported, *inter alia*, in Figures 9A and 9B and the associated text in the specification. Specifically, Figure 9A shows the display of a first portion that corresponds to a first selection, and Figure 9B shows the display of a second portion that corresponds to a second selection. Note the location of the "scroll box" in the scroll bar 96 on the right-hand side of Figures 9A and 9B. The scroll box's position in the scroll bar 96 indicates the relative location in a larger scrollable portion of what is displayed. In both Figures 9A and 9B, the scroll box is at the very top of the scroll bar 96. This shows that the first and

second portions are not subsets of a larger scrollable portion because, if they were, the scroll box would be in different locations in the scroll bar 96 in the two figures.

Turning now to dependent Claims 81 and 82, these claims recite that the first and second buttons operate independently of a scroll functionality. The first and second buttons, when pressed, cause the display of the first and second portions, respectively. As discussed in the preceding paragraph, the first and second portions are not subsets of a larger scrollable portion. Accordingly, the first and second buttons, which are used to cause the display of the first and second portions, respectively, operate independently of a scroll functionality. That is, if the operation of the first and second buttons were dependent on scroll functionality, the scroll box would be in different locations in the scroll bar 96 in the two figures. Further, page 15, lines 6-8 of Applicants' specification recite: "The user *may also navigate within the section by controlling the display window scroll bar 96* with the screen pointer 62 and the selecting device 102" (emphasis added). The teaching that the user may *also* navigate by using the scroll bar 96 shows that the first and second buttons operate independently of a scroll functionality. Otherwise, the teaching that "the user may *also* navigate" would be redundant.

During the telephone interview, the Examiner accepted Applicants' position of support in the specification but objected to the use of a negative limitation. The Examiner noted that MPEP 2173.05(i) states that "[a]ny claim containing a negative limitation which does not have basis in the original disclosure should be rejected." However, Applicants respectfully note that MPEP 2173.05(i) also states that there is nothing inherently ambiguous or uncertain about a negative limitation and that a lack of literal basis in the specification does not necessarily establish a lack of descriptive support. MPEP 2173.05(i) further states that "[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." Such is the

situation here. Since the specification discloses both operating dependently and independently of a scroll functionality, as well as portions that are and are not subsets of a larger scrollable portion, the claims can recite operating independently of a scroll functionality and portions that are not subsets of a larger scrollable portion. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, first paragraph, rejections of Claims 81-84.[1]

III. 35 U.S.C. § 103(a) Rejections

Independent Claims 65 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of "EBT Workshop Description: Introduction to Electronic Publishing with DynaTag and DyntText" (hereinafter, "DynaText") and U.S. Patent No. 5,867,729 to Swonk. Applicants respectfully request reconsideration and withdrawal of these rejections for the reasons set forth below.

As a first matter, page 5 of the Office Action asserts that DynaText "discloses the ability to bind queries to function elements in order to store custom searches" in a section entitled "Binding Query Forms." During the telephone interview, Applicants challenged whether DynaText, in fact, teaches this feature and noted that they could not find any section in DynaText entitled "Binding Query Forms" (the term "binding" was used in Swonk). The Examiner explained that the section to which he was referring is entitled "DynaText Queries/Searching" and that page 4 of that section teaches defining a function name for a proximity search. Applicants noted that page 4 of that section discusses providing a search form that contains variable fields that are completed by a user when he desires to perform a search. There is a "Word" variable (for the user to specify a word he is looking for), a "Near word" variable (for the

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[1] It should be noted that the passages in the specification that were cited for support of the claims should not be read as limitations on the claims in this application or in other applications in this family.

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user to specify a word near the word he is looking for), and a "Within how many words" variable (for the user to specify the allowed number of words between the "Word" and the "Near word"). This section makes clear that the fields in the search are variable and set by the user — they are not static fields with "hard-coded" search terms. The "custom search" in DynaText is customized in the sense that the *type* of search (e.g., proximity search, etc.) is customized — not that the terms in the search fields are static. The considerations for designing a custom search (e.g., what kind of feature will distinguish the target, how to restrict the search, etc.) discussed on page 3 of the DynaText section make this clear.

As discussed during the telephone interview, with the proper reading of DynaText, the proposed combination merely results in the activation of a search form by pressing a function button — not in a search of "hard-coded" search terms in static fields. Because pressing a button in the proposed combination merely activates the search form and not the execution of a search of certain data, pressing of a button in the proposed combination does not cause a processor to receive a first selection corresponding to a first portion of web information and displaying the first portion of the web information, as recited in the claims. The Examiner agreed that the proposed combination of DynaText and Swonk does not yield the claimed invention. Accordingly, Applicants respectfully submit that the rejections of independent Claims 65 and 73 and their dependent claims should be withdrawn.

During the telephone interview, the Examiner indicated that he would perform a search to find a prior art reference teaching replacing a variable field with a static field to cure the deficiency in the proposed combination. As a first matter, Applicants respectfully request that, if such a search is performed, the new Office Action be made non-final. Additionally, as Applicants explained during the telephone interview, even if a prior art reference is found

teaching replacing a variable field with a static field, DynaText teaches away from such a modification. The whole purpose of the proximity search in DynaText is to have variable search fields, so the user can enter any given data value he wants to search. Replacing the variable search field with a static search field would completely eliminate this basic functionality and is taught against by DynaText. Instead of providing a tool for a user to enter any given data value he wants to search, the tool in the proposed combination would be hard-coded to search for the same data every time the button is pressed. Such a modification is taught against by DynaText.
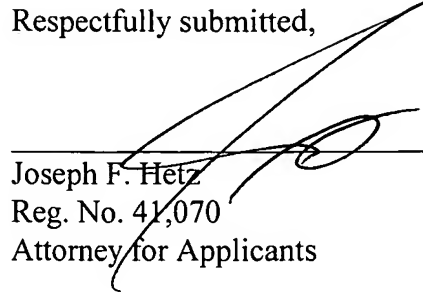
IV. Conclusion

In view of the above remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully submitted. It should be noted that while only some elements of the independent claims were discussed above, other elements of the independent claims, as well as the dependent claims, provide additional grounds of patentability. Applicants reserve the right to present these additional grounds at a later time, if necessary.

The Director is hereby authorized to charge payment of any additional fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

If the Examiner has any questions, he is invited to contact the undersigned attorney at

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